

Remarks

Reconsideration of this Application is respectfully requested.

Claims 1-56 are pending in the application, with claims 1, 21, 41, 53, 54, and 56 being the independent claims. Claims 8-17, 19, 20, 28-37, 39, 40, 45-52, 54, and 55 have been withdrawn.

This Reply is made in response to an outstanding Requirement for Information mailed Nov. 18, 2005 ("Information Requirement"). Applicants respectfully submit that aspects of the Requirement are overbroad and improper. Nevertheless, to expedite prosecution, Applicants provide this Reply and submit information fulfilling proper aspects of this Information Requirement, as can be best understood from the Information Requirement. Applicants submit that this Reply and the information provided herein more than satisfies the scope of the type of information that the Examiner can properly obtain under 37 C.F.R. § 1.105.

For at least the reasons noted herein and in the absence of any rejection or objection, Applicants respectfully submit the application is in condition for allowance. Prompt and favorable consideration is requested.

Telephonic Interview

Applicants thank Examiner Nathan Hillery for the telephonic interview with Applicants' representatives, Mr. Michael Messinger and Mr. Timothy Doyle, on April 19, 2006. During the interview, Applicants' representatives: (1) expressed their concerns regarding the scope of the outstanding Requirement for Information Under 37 C.F.R. § 1.105, and (2) requested clarification of the meaning of terms used in some of the interrogatories included in the Requirement for Information.

Specifically, Applicants' representatives argued that the interrogatories were over broad and improper as they call upon Applicants to render an opinion and/or divulge attorney-client privileged information. In particular, Applicants argued that they were not required to submit information regarding: (1) the identification of art that might interfere or infringe with the claimed invention, (2) arguments that might be presented in a hypothetical interference proceeding or hypothetical action for infringement, or (3) comparing and contrasting the claimed invention with purportedly related art. In response to these concerns Examiner Hillery stated that he is seeking just factual information and is not looking for individuals associated with the prosecution of the patent application to provide their opinions. Examiner Hillery suggested that a complete reply may be a list of factual information along the lines of inquiry in the Information Requirement and that such a reply might resemble, for example, a listing of documents, such as, is typically provided in a Form PTO-1449 submitted with an Information Disclosure Statement.

Additionally, Applicants' representatives asked Examiner Hillery to explain what he meant by the phrase "term of degree" as used in the statement: "Please note that "propagative" is a term of degree, which needs to be definitely defined." Noting that the term "propagative" was used in the claims to modify the term "poster," Examiner Hillery explained that he would like to know the extent to which the poster can be propagated.

Agreement was not reached.

Reply to the Requirement for Information Under 37 C.F.R. § 1.105

Scope of Interrogatories

The following interrogatories were included at paragraph three of the Requirement for Information Under 37 C.F.R. § 1.105 (emphasis added):

- a. Is there a potential interference or is the Applicant planning to pursue interference proceedings upon allowance regarding this application?
- b. Are there any references, sources, publications, applications, services, products or any other form of art of which the Applicant, Applicant's representative, or Assignee is aware might infringe upon or be deemed to interfere with the instant application?
- c. If the answer to "a" or "b" is yes, what component(s) and/or limitation(s) would be argued in an interference proceeding or deemed to be substantially similar to some form of art?
- d. The debatable limitation(s) of the claimed invention rests with the interpretation and definition of "propagative poster". Compare and contrast the claimed invention specifically a "propagative poster" with what is believed by Applicant to be the closest art known – not just prior art.
- e. In the broadest, most reasonable interpretation, the claimed "propagative poster" is an ad banner, which simply accesses host site content and provides host site content to remote users over the World Wide Web. Compare and contrast the difference between "propagative poster" and an "ad banner", which is a well-established term of art. Please note that "propagative" is a term of degree, which needs to be definitely defined.

As stated in the earlier telephone interview, Applicants' representatives contend that these interrogatories exceed the scope of the type of information that the Examiner can properly obtain under 37 C.F.R. § 1.105. At the very least, to the extent that the interrogatories call upon Applicants to render an opinion and/or divulge attorney-client privileged information including submitting information regarding (1) the identification of art that might infringe or interfere with the claimed invention, (2) arguments that

might be presented in a hypothetical interference proceeding or hypothetical action for infringement, or (3) comparing and contrasting the claimed invention with purportedly related art, such interrogatories are overbroad and impermissible and exceed the scope of the type of information that the Examiner can properly obtain under 37 C.F.R. § 1.105.

Section 704.11 of the Manual of Patent Examining Procedure provides (emphasis added):

The terms "factual" and "facts" are included in 37 CFR 1.105 to make it clear that it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are sought, and that requirements under 37 CFR 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant.

Section 704.11 reduces to writing the decision of the PTO explicitly to exclude information in the form of an opinion from that information that may be required under 37 C.F.R. § 1.105 (hereinafter "Rule 105").¹ In 2003, the PTO proposed to amend then existing Rule 105, *inter alia*, to redesignate then existing paragraph (a)(3) as new paragraph (a)(4) and to modify new paragraph (a)(4) to "recognize that information in the form of opinion might not be held, and permit a reply to a requirement for opinion to be considered complete where it is stated that an opinion is not held."² The Federal Register summarized: (1) the comments received in response to the proposed amendments and (2) the responses by the PTO to the summarized comments.³ Included among these was the Response to Comment 67, which stated (emphasis added): "To the

¹ Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan, 69 Fed. Reg. 56512 (Sept. 21, 2004) (to be codified at 37 C.F.R. pt. 1).

² Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan, 68 Fed. Reg. 53832 (proposed Sept. 12, 2003) (to be codified at 37 C.F.R. pt. 1).

extent that such comments are directed toward the elucidation of opinions and legal conclusions, the comments are adopted and the rule has been amended to remove the term "opinion."⁴

Accordingly, in keeping with the requirements of current Rule 105 and with the statements made by Examiner Hillery during the April 19, 2006, teleconference, Applicants' representatives will limit the information provided herein to facts and factual information.

Further, it is unclear to whom the interrogatories are directed. The Examiner refers to "Applicant", "Applicant's representative," or "Assignee" differently across the interrogatories. The present patent application has had multiple assignees: icPlanet Corporation, ICP Acquisition Corporation, icPlanet Corporation, Hall Kinion & Associates, and KForce, Inc. ("KForce"). KForce acquired Hall Kinion, which had acquired icPlanet Corp. KForce is the current owner of the present application. The inventors, Michael Foulger and Peter van Gorder, developed the invention and filed the present application while working at icPlanet Corp. In preparing this Reply, Applicants' representatives, Timothy Doyle and the undersigned, Michael Messinger, consulted with inventors, Michael Foulger and Peter van Gorder, and David Kelly, Vice President of Finance at KForce, Inc. (collectively referred to below as "Applicants").

³ Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan, *supra* note 1, at 56513-16.

⁴ *Id.* at 565513; *see also* the Response to Comment 70 at 56514, the Response to Comment 72 at 56514, the Response to Comment 77 at 56514, and the Response to Comment 84 at 56515 (each of which reiterates that individuals associated with the prosecution of a patent application will not be required to provide information in the form of an opinion).

Response to Interrogatories at Paragraphs 3(a)-3(c)

Applicants are unaware of a potential interference between the present application and any pending United States patent application and any issued United States patent.

To the extent that these interrogatories call upon Applicants to render an opinion regarding the identification of products or services that might infringe with the claimed invention, Applicants' representatives contend that these interrogatories exceeds the scope of the type of information that the Examiner can properly obtain under current Rule 105.

To expedite prosecution and without acquiescing to the propriety of the Examiner's request, to the best of Applicants' knowledge the product or service that may have incorporated the claimed subject matter was a "Data 2 Go" feature of icPlanet.com website (now defunct).

Applicants submit that this information more than adequately meets the scope of the type of information that the Examiner can properly obtain under current Rule 105 (as provided at Section 704.11(a)(B) of the Manual of Patent Examining Procedure) and is submitted to ensure that the present Reply is a bona fide Reply.

To expedite prosecution and without acquiescing to the propriety of the Examiner's request, to the best of Applicants' knowledge the following is a list of the trade names and providers of goods or services that may have been or may be in competition with goods or services embodying the claimed subject matter:

(1) News.com.com - using the RSS/XML data feed (ex: <http://news.com.com/2547-1 3-0-20.xml>) is an example that may allow a subscriber site

to present dynamic data from the news.com site. This example may not include one or more of the following function(s): the ability to custom configure what data is presented, the ability to present a dynamically generated image file of that data, the ability to present the data via an encrypted link, the ability to present a trackable image map overlaying that data which allows tracking of the location in the image that was clicked, the ability to present the ability to propagate this data to subsequent sites, or the ability to track when new sites have elected to propagate the data.

(2) Weather.com "Weather on Your Site" feature (ex: <http://www.weather.com/services/oap.html?from=servicesindex>) is an example that may allow a subscriber to include some dynamic data and an image file from a weather.com site. This example may not include one or more of the following function(s): the ability to present a dynamically generated image file of that data, the ability to present the data via an encrypted link, the ability to present a trackable image map overlaying that data which allows tracking of the location in the image that was clicked, the ability to present the ability to propagate this data to subsequent sites, or the ability to track when new sites have elected to propagate the data.

Also, to the best of Applicants' knowledge, any online advertising or affiliate 'click-through' program that attracts users to click on an image or text link and be navigated to the advertiser's site, that also tracks this 'click-through' event is an example that allows a subscriber to include an image file or text link from the publishing site. Subsequent click-throughs may be tracked in some manner. However, even these cases may not include one or more of the following function(s): the ability to custom configure what data is presented, the ability to present a dynamically generated image file of that

data, the ability to present the data via an encrypted link, the ability to present a trackable image map overlaying that data which allows tracking of the location in the image that was clicked, or the ability to present the ability to propagate this data to subsequent sites.

This information is not an infringement analysis nor should it be construed as such. Applicants submit that this information more than adequately meets the scope of the type of information that the Examiner can properly obtain under current Rule 105 (as provided at Section 704.11(a)(E) of the Manual of Patent Examining Procedure) and is submitted to ensure that the present Reply is a bona fide Reply.

Furthermore, the information above is also included in Forms PTO-1449 submitted with a Second Supplemental Information Disclosure Statement filed herewith. Applicants respectfully request that the Examiner return to Applicants' representatives copies of the Forms PTO-1449 submitted with this Information Disclosure Statement after the Examiner has indicated his consideration of the documents identified therein.

Response to Interrogatory at Paragraph 3(d)

Applicants' representatives provide information below regarding support for the term "propagative poster". This information more than adequately meets the scope of the type of information that the Examiner can properly obtain under current Rule 105 (as provided at Section 704.11(a)(S)(3) of the Manual of Patent Examining Procedure) and is submitted to ensure that the present Reply is a bona fide Reply.

The term "propagative poster" is described, *inter alia*, at page 10, lines 11-14 of the specification of the present patent application:

The term "propagative poster" refers to any type of poster created and managed according to the present invention. Such a "poster" can

include, but is not limited to, any one or more of an image, bitmap, link, button, window, display view, and/or applet.

Further information about a propagative poster is provided, *inter alia*, at page 11, line 21 through page 12, line 4; at page 12, line 29 through page 13, line 1; at page 13, line 14 through page 14, line 6; and at figures 2A through 2D of the specification of the present patent application:

FIGs. 2A-2D show one example series of screens for configuring and propagating a propagative poster. FIG. 2A shows a first configuration screen 210. Configuration screen 210 includes images of different types of sample posters that can be configured by user. In this example, four sample types of posters can be selected by a user. The first type is a window that displays job posting information at a host site. The second type is a window that displays resume information at the host site. The third type is a search button that enables a user to perform a search of data at the host site. The fourth type of poster is a data display window that displays information. For example, a data display representing statistical information about data on the host site can be provided in a propagative poster. . . . As shown in FIG. 2C, a third configuration screen 230 is then displayed that shows the user configured propagative poster as it would appear on a web page. . . . FIG. 2D shows an example screen 240 that illustrates steps 120-150. Example screen 240 includes an example Web code segment generated according to steps 120-130. The Web code segment is HTML text and includes a propagative poster identifier and a link to the host site. The HTML text is sent over an HTTP link for display in the browser of the remote user (step 140). For example, as shown in FIG. 2D the HTML text can be provided in a box within the screen 240 to enable a user to easily select the HTML text. The user can then cut and paste the HTML text into another remote Web page as described with respect to step 150.

Note screen 240 also includes instructions to guide the user to further facilitate easy cutting and pasting of the HTML code segment. Alternatively, the Web code segment can be automatically inserted by the host site into a designated Web page of the remote user. This of course requires that the host site be granted access rights to write on the Web server of the remote user.

The display screens 210 through 240 described with respective FIGS 2A through 2D are illustrative and not intended to limit the present invention. For example, a smaller or larger number of screens can be

used. Different types of information and format can be included in screens 210-240 in accordance with the present invention. Any type of user input entry device can be used, including but not limited to templates, forms or other data entry modes.

Further support for the degree to which a propagative poster can be propagated is addressed, *inter alia*, at page 18, lines 25 and 26; at page 19, lines 14-17; at page 20, lines 26 through page 21, line 24; and at figures 1, 3 through 6, 9A, 9B, 10A, and 10B of the specification of the present patent application:

Propagative poster generator 330 then generates a propagative poster identifier that includes a unique poster number (step 926). . . . PP generator 330 then generates a non-executable HTML code segment 410 that includes secure, trackable PPID 560 and a link (URL) to host site 302 (step 930). PP generator 330 further generates executable code. PP generator 330 then generates and stores a PP record 600 in storage device 312 (step 934). . . . Propagative poster manager 310 then sends the non-executable HTML code segment 630 to browser 372 at client 370 (step 936). User 1 through browser 372 then inserts non-executable HTML code segment into a Web page (step 938). As described with respect to step 150, the non-executable HTML code segment can be inserted manually (e.g., cut and pasted) by a user or automatically by host site 302.

Further Propagation

The distribution of propagative posters is further described with respect to FIGS. 10A and 10B. Remote user n (e.g. user 2) visits user 1 web page (step 1002). Remote server then interprets HTML code segment 410 (step 1004). Browser 382 is then linked to host site 302 and Web server 316. Propagative poster tracker 340 parses the originating URL (User 1's URL), and secure trackable PPID 560 (step 1006).

PP tracker 340 further tracks the referring URL of server 376. In step 1008, PP tracker 340 checks whether a valid poster ID is obtained. For example, PP tracker 340 decrypts fingerprint 540 with a copy of the private key previously stored in host site 302 and compares it with the unique poster number or ID 520 to determine if the poster ID that is valid. If a valid poster ID has not been sent, then PP tracker 340 ignores

the remote user n (step 1010). Otherwise, when a valid poster ID is verified, PP tracker 340 determines whether the URL of remote user n equals the originator URL of user 1 (step 1012). If the URL of remote user n is not equal then PP tracker 340 recognizes that a different user is accessing the poster and stores the URL of remote user n (step 1014) and proceeds to step 1016. Otherwise, propagative poster tracker 340 proceeds directly to step 1016.

In step 1016, propagative poster tracker 340 updates the history information of propagative poster. In particular, the history is updated to indicate that an access to the propagative poster has been made and to provide a history of the accessing URL and time stamp information.

The term "propagative poster" and the degree of propagation is not necessarily limited to these examples and embodiments and is entitled to a broad meaning based on plain meaning of the claim language and in accordance with proper claim construction principles.

To the extent that this interrogatory calls upon Applicants to render an opinion comparing and contrasting the claimed invention with purportedly related art, Applicants' representatives contend that this interrogatory exceeds the scope of the type of information that the Examiner can properly obtain under current Rule 105.

Response to Interrogatory at Paragraph 3(e)

Regarding the phrase "ad banner," the Examiner has not cited any art using this phrase. Accordingly, in the absence of a proper *prima facie* rejection, Applicants' representatives are not in a position to compare the claimed invention with an ad banner as called for by the Examiner. However, to expedite prosecution Applicants' representatives provide below a list of United States Patents or United States Patent Application Publications that include the phrase "ad banner" in the abstract or the claims found in a search performed by Applicants in response to the Examiner's request. This

information more than adequately meets the scope of the type of information that the Examiner can properly obtain under current Rule 105 (as provided at Section 704.11(a)(P) of the Manual of Patent Examining Procedure) and is submitted to ensure that the present Reply is a bona fide Reply:

5,796,952
6,188,398
6,829,780
20010011226
20010047297
20020004733
20020073343
20020082923
20020103698
20020147637
20020152238
20030046148
20030128297
20040220821
20050171863
20050289005
20060085263

Furthermore, the United States Patents or United States Patent Application Publications included on the above list are also included in Forms PTO-1449 submitted with the Second Supplemental Information Disclosure Statement filed herewith. Applicants respectfully request that the Examiner return to Applicants' representatives copies of the Forms PTO-1449 submitted with this Information Disclosure Statement after the Examiner has indicated his consideration of the documents identified therein.

To the extent that this interrogatory calls upon Applicants to render an opinion comparing and contrasting the claimed invention with purportedly related art, Applicants' representatives contend that this interrogatory exceeds the scope of the type of information that the Examiner can properly obtain under current Rule 105.

Response to Requirement for Factual Information at Paragraph 4

As mentioned above, to the best of Applicants' knowledge the product or service that may have incorporated the claimed subject matter was a "Data 2 Go" feature of icPlanet.com website (now defunct).

Applicants contend that this Reply is full and complete and request that the Examiner indicate his consideration of the Reply in the manner provided at Section 704.14(b) of the Manual of Patent Examining Procedure. Should the Examiner dispute this contention, Applicants respectfully request that the Examiner recognize this Reply as a bona fide Reply and issue an extension of time to complete the Reply as provided at Section 704.12(c) of the Manual of Patent Examining Procedure. In the absence of such an issuance, Applicants will conclude that the Examiner has deemed this Reply to be full and complete.

A continuing application, Appl. No. to be assigned, claiming the benefit of priority to the instant application, 09/551,746, has been filed on May 18, 2006.

Outstanding Information Disclosure Statement

Applicants respectfully request that the Examiner indicate his consideration of the documents identified in the Information Disclosure Statement that was timely filed on February 15, 2002. Applicants respectfully request that the Examiner return to Applicants' representatives a copy of the Form PTO-1449 submitted with this Information Disclosure Statement after the Examiner has indicated his consideration of the documents identified therein. An extra copy of this Form PTO-1449 is attached herewith for convenience.

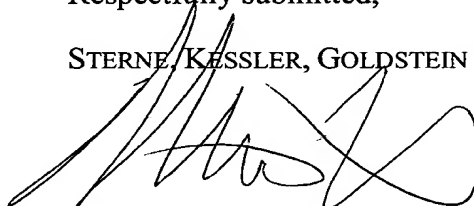
Conclusion

Applicants believe that a full and complete reply has been made to the outstanding Requirement for Information Under 37 C.F.R. § 1.105 and, as such, the present patent application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this patent application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read 'Michael V. Messinger', is written over the printed name and firm name.

Michael V. Messinger
Attorney for Applicants
Registration No. 37,575

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1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600